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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,678	01/16/2004	B. Raghav Reddy	HES 2003-IP-011937U1	8611
28857	7590	02/16/2006	EXAMINER	
CRAIG W. RODDY HALLIBURTON ENERGY SERVICES P.O. BOX 1431 DUNCAN, OK 73536-0440			MARCANTONI, PAUL D	
			ART UNIT	PAPER NUMBER
			1755	
DATE MAILED: 02/16/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/759,678

Applicant(s)

REDDY ET AL.

Examiner

Paul Marcantoni

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/7/05.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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Response to 11/9/05 Restriction:

Applicant's election with traverse of Group I, claims 1-39, in the reply filed on 12/9/05 is acknowledged. The traversal is on the ground(s) that the examiner has not made a compelling reason under MPEP 808.02 and the timing of the restriction is improper. This is not found persuasive because MPEP 811 states with respect to timing that while a restriction requirement is normally made before any action on the merits, it may be made at *any time before final rejection*. It also states that it should be made as soon as possible when that need develops. Applicants' amendment to changing their invention from simply a method of cementing and placing in a subterranean formation (applicants thus implying that they are cementing a *wellbore* which is the crux of their invention-see paragraph [0002] on page 1 of applicants' specification) resulted in the need for a restriction requirement.

The applicants state the examiner has not made a compelling reason under MPEP 808.02. The examiner has shown that the inventions of Groups I and II have separate classifications (class 166 and class 106 respectively) and thus different fields of search. The search of either Group I does not require a search in Group II and vice versa. The examiner has met the serious burden requirement also by his proper holding for this restriction which has not been traversed by applicants in their response. The requirement is still deemed proper and is therefore made FINAL.

Obviousness-Type Double Patenting:

Claims 1-39 remain rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-13 of US Patent No. 6,796,378 B2 (Reddy et al.). Reddy et al. teach applying his cement composition comprising cationic polymer (cationic derivatized starch), calcium aluminate, water, and retarder (col.2, line 46) for a well cement.

The applicants' submitted terminal disclaimer appears to be approved. However, the examiner has maintained his rejection because applicants indicated they requested to withdraw their submitted terminal disclaimer. The applicants indicated they requested to withdraw the previously filed Terminal Disclaimer as stated on page 21, second to last paragraph of applicants' response. The applicants should note that they have to *petition to withdraw a terminal disclaimer* that has already been approved.

Applicants can still choose to change their minds and permit the submitted terminal disclaimer to overcome this rejection.

35 USC 112 Second Paragraph:

Claims 1-39 are rejected under the second paragraph of 35 USC for failing to particularly point out and distinctly claim applicants' invention.

Claim 1 is vague and indefinite because the cement composition cannot be activated without water. Water is the ingredient that starts the hydraulic reaction with cement and without water there is no activating any cement composition. Applicants may consider insertion of claim 2 (water) into claim 1.

The terms “high” density particles are definite term in claim 7. The applicants define this term on page 20 of their specification as meaning *particles that are heavier than the settable fluid to which the particles are to be added*.

The terms “desired” listed twice in claim 14 is indefinite as it is in claim 25 and any other claim it is utilized.

The applicants should amend –the—cement composition lacking the particle size distribution agent to –a--- cement composition lacking the particle size distribution agent in claim 26. “The” cement composition lacks antecedent basis and thus the need for the change to –a--. Note that only a cement comprising a particle size distribution adjusting agent is in claim 1.

The use of parentheses is improper in claim 30. Simply removing the parentheses would resolve this issue.

35 USC 102/103 Rejection

Claims 1-39 are rejected under 35 U.S.C. 102(a and b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over *Laramay et al.* '318, *Abelleira et al.* '147 B1, *Yamashita et al.* '418, *Cowan* '711 or '654 or '070, *Vijayendran et al.* '832 B1, *Nadolsky et al.* '603, *Smith et al.* '939, *Booth* '407, *Lu et al.* (CN 1385388), *JP 2000191350* (Tobori et al.), *JP 09020536* (Tamura et al.), *Mizunuma et al.* (JP 06128001), *Koizumi* (JP 05043293), *Yamaguchi et al.* (JP 61256956), *JP 59109663* (Takenaka Komuten Co), or *Borchardt* (DE 3213799) alone or in view of *Vijn et al.* '488 or *Chatterji et al.* '203

All of the primary references above teach a method of cementing a subterranean formation including using a particle size distribution adjusting agent as stated in the first non-final office action on the merits. Not all of the primary references teach a retarder however. Yet, a retarder is notoriously known for slowing the setting of cement and is a conventional additive used in the art for both construction purposes and well cementing. Vijn et al. '488 teach on column 4 lines 24-35 that the addition of a retarder to a well cement is old in the art. Chatterji et al. '203 also teach the use of a retarder for well cements are known in the art (see claim 1). Thus, the use of a retarder to slow setting even in well cements or subterranean formations (of which a well cement is) would have been an obvious design choice for one of ordinary skill in the art.

Response

First, the examiner regrets any misunderstandings regarding previously rejected claims under 35 USC 112 second paragraph. Previous rejections not mentioned were withdrawn as a result of applicants' arguments/comments. Only remaining rejections were stated in the office action.

The applicants argue for all references in the 102/103 rejection that none of the prior art teaches activation of a cement composition. In rebuttal, the examiner disagrees. Water is the activating agent for a cement composition and all cement compositions must contain water to activate the hydraulic properties and lead to a settable material. All of the prior art references teach adding water to their cement composition and thus teach "activating" their cement composition. Applicants are referred to their own independent claim 1 which contains no activating agent because

there is no mention of water in claim 1. A cement composition cannot be activated without water.

The applicants also argue references that teach wall board cement compositions and note that they do not teach placement in a subterranean formation. The examiner disagrees and notes that wallboard such as gypsum wallboard is likely placed in a subterranean formation on a daily basis in the construction industry. Drywall or gypsum wallboard is often used to create a finished basement for homeowners. A basement is a subterranean formation as it is sub (below) the terra (earth or ground level).

It would appear that applicants arguments to "subterranean formation" are implying *cementing a wellbore* which is a subterranean formation. This is the whole purpose of applicants' process as it is directed to a wellbore (See paragraph [002] of applicants' specification). However, the applicants cannot imply or argue something they do not claim because they are not claiming a wellbore so any subterranean formation including basements, wall foundations, etc. read upon the presently claimed invention. They would not had applicants amended their claim to method of cementing a wellbore but this limitation is not in the claim. This is not a suggestion but merely an observation of what applicants appear to argue (for their limitation) yet is not actually in the claim. It is also noted that cement/concrete is notoriously known in the art for use in a subterranean formation whether its for reinforcement of a post or fence, for example, or part of a foundation for a building or a house. This applies to all references that use a cement material or concrete because it is understood that these materials are conventionally used in subterranean formations. Note that many of these references do

not teach a *wellbore* so they would not meet the limitations had applicants actually had this term in their independent claim 1 and would have to be withdrawn. Only references that do or potentially read upon a wellbore would remain. Still, this term is not in the claim so they have not been withdrawn. Again, this is not a suggestion but an observation of the present state of applicants' claims.

With respect to the Booth reference which teaches a process for backfilling mines, Booth does teach adding a cationic polymer (particle size distribution adjusting agent) and water (activating agent for cement). The applicants argue that Booth does not teach adding a retarder. Yet, a retarder is a conventional additive to virtually any cement composition and the addition of a retarder would have been an obvious design choice for one of ordinary skill in the art.

The term "particle size distribution adjusting agent" has also been given its broadest possible meaning. While the applicants mean a cationic polymer, they are not actually claiming that in claim 1 and it is improper to read the limitations of their specification or dependent claims (teaching cationic polymer) into claim 1. Therefore, this term can also be interpreted to mean a substance such as water, a thickener, a dispersant or surfactant, etc. or any substance that can potentially have an effect on particle size distribution. Each one of these conventional additives as well as potentially others not mentioned can adjust particle size distribution. Applicants may again consider at the very least the insertion of cationic polymer into claim 1 to avoid these broad but permissible interpretations of a particle size distribution adjusting agent.

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Finally, It is the examiner's position that he has addressed applicants' arguments fully as stated above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Marcantoni
Primary Examiner
Art Unit 1755